

ESTTA Tracking number: **ESTTA719603**

Filing date: **01/11/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92060464
Party	Plaintiff Safeside Tactical, LLC
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Attachments	Reply in Support of Petitioners MSJ.pdf(299601 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board

In the matter of U.S. Registration No. 4,509,171;
For the mark SAFESIDE;
Registered on the Principal Register on April 8, 2014.

Safeside Tactical, LLC,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92060464
	:	
CheyTac USA, LLC,	:	
	:	
Registrant.	:	

PETITIONER’S REPLY IN SUPPORT OF PETITIONER’S
MOTION FOR SUMMARY JUDGMENT

COMES NOW the Petitioner, Safeside Tactical, LLC (hereinafter “Petitioner”), by and through counsel, The Trademark Company, PLLC, and pursuant to TBMP § 528 *et seq.* files the instant Reply in Support of Petitioner’s Motion for Summary Judgment filed on or about August 26, 2015. In support of the instant motion Petitioner states as follows:

STATEMENT OF FACTS

1. Registrant contends that it is the owner of U.S. Registration No. 4,509,171 for the mark SAFESIDE (hereinafter “Registrant’s Mark”) authorized for use in connection with the following goods, namely: “Ammunition for firearms; Breeches of firearms; Firearm sights; Firearms; Foresights for firearms; Gunsights for firearms; Non-telescopic gun sights for firearms; Supplemental chambers for firearms,” (hereinafter “Registrant’s Goods”) in International Class 13.
2. Registrant filed its Application for Registrant’s Mark for use in connection with Registrant’s Goods on or about February 2, 2013.
3. Registrant’s Application for Registrant’s Mark received U.S. Serial No. 85/839,213.
4. On or about April 8, 2014, Registrant’s Mark published on the Principal Register and received U.S. Registration 4,509,171.

5. Registrant's Registration claims a date of first use in commerce of Registrant's Mark for Registrant's Goods on December 15, 2012.

6. Petitioner is the owner of Federal Trademark Application Serial No. 86/201,940 for the mark SAFESIDE TACTICAL (hereinafter "Petitioner's Mark") for use in connection with the following services, namely: "On-line retail store services featuring firearms and related items; Retail store services featuring firearms and related items," (hereinafter "Petitioner's Services") covered in International Class 35.

7. Petitioner's Application claims a date of first use of Petitioner's Mark in connection with Petitioner's Services on November 15, 2012 and a date of first use in commerce on December 2, 2012.

8. On or about December 1, 2014 Petitioner filed a Petition to Cancel Registrant's Registration for Registrant's Mark on the grounds of priority of use and likelihood of confusion pursuant to Trademark Act Section 2(d).

9. On or about January 9, 2015 Registrant filed an Answer to the Petition to Cancel.

10. On or about January 15, 2015 Registrant filed a Motion to Grant Corrected Date of First Use Without Consent pursuant to 37 CFR § 2.175 and TBMP § 514.01 seeking an order from the Board amending the date of first use claimed on Registrant's Registration from December 15, 2012 to June 24, 2011.

11. On or about January 27, 2015 Registrant's former counsel, the late Jerry Romanoff, President of Cheytac USA, LLC: David McCutcheon and Petitioner's undersigned counsel timely held the mandatory Discovery Conference in this matter.

13. On or about February 9, 2015 the Board entered an Order allowing Registrant until on or about March 11, 2015 to submit the required fee and/or declaration in support of the amendment to Registrant's Registration as set out in Registrant's Motion to Grant Corrected Date of First Use Without Consent.

14. On or about February 9, 2015 Registrant filed a Reply in Support of Registrant's Motion to Grant Corrected Date of First Use Without Consent.

15. On or about February 13, 2015 Petitioner served its Initial Disclosures to Counsel for Registrant by U.S. Mail.

16. On or about June 5, 2015 the Board entered an Order denying Registrant's Motion to Grant Corrected Date of First Use Without Consent and resetting the trial dates in the instant case. Per the Board's new trial order entered on or about June 5, 2015 the discovery period opened in this case on July 6, 2015 and closed on January 2, 2016.

17. On or about July 6, 2015 Petitioner served Petitioner's First Set of Requests for Admissions, Requests for Production of Documents and Requests for Interrogatories to Registrant by U.S. Mail. *See* Petitioner's Motion for Summary Judgment, Exhibit A.

18. Counsel for Petitioner emailed courtesy copies of Petitioner's aforementioned discovery requests to Registrant's Counsel on July 6, 2015. *See* Petitioner's Motion for Summary Judgment, Exhibit B.

19. The deadline for Registrant to submit its responses to Petitioner's First Set of Requests for Admissions, Requests for Production of Documents and Requests for Interrogatories to Registrant was on or about August 10, 2015.

20. On or about August 26, 2015 Petitioner filed a Motion for Summary Judgment and corresponding Exhibits A-C on the following grounds:

- a. Priority and likelihood of confusion with Petitioner's Claimed Mark pursuant Section 2(d) of the Trademark Act; and
- b. No genuine issues of material fact exist that can contradict Petitioner's claims of priority of use over Registrant.

19. On or about September 10, 2015 the Board entered an Order suspending the instant proceeding pending the disposition of Petitioner's Motion for Summary Judgment.

21. The deadline for Registrant to file a Response to Petitioner's Motion for Summary Judgment was on or about September 30, 2015.

22. On or about November 6, 2015 Registrant's new counsel filed a Notice of Appearance as Counsel for Registrant stating that Registrant's former counsel, Gerald Romanoff, passed away on April 4, 2015. See Registrant's Notice of Appearance of Counsel.

23. On or about November 6, 2015 Registrant, by counsel, filed a Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment and corresponding Exhibits A-C.

24. On or about November 9, 2015 Registrant, by counsel, filed a Motion to Reopen Time to Respond to the Board's Order on Registrant's Motion to Grant Corrected Date of First Use Without Consent (collectively, with the Registrant's Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment hereinafter referred to as "Registrant's Motions to Reopen") and corresponding Exhibits A-D.

25. On or about November 25, 2015 Petitioner filed an Opposition to the Registrant's Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment and Registrant's Motion to Reopen Time to Respond to the Board's Order on Registrant's Motion to Grant Corrected Date of First Use Without Consent.

26. On or about November 28, 2015 the Board entered an Order allowing the thirty (30) day or until on or about December 28, 2015 to file an Opposition to Petitioner's Motion for Summary Judgment.

27. On or about December 22, 2015 Registrant filed an Opposition to Petitioner's Motion for Summary Judgment and corresponding Exhibits A-J.

28. On or about December 22, 2015 Registrant filed a Second Motion to Grant Corrected Date of First Use Without Consent.

29. On or about December 30, 2015 Registrant filed an Amended Second Motion to Grant Corrected Date of First Use Without Consent.

SUMMARY OF REGISTRANT'S RESPONSE

The Registrant contends in its Opposition to Petitioner's Motion for Summary Judgment ("Registrant's Motion") that the Petitioner's Motion for Summary Judgment should be denied on the following grounds:

- i) That Registrant's Responses to Petitioner's Requests for Admissions should not be deemed admitted because no discovery conference was held and Registrant did not receive Petitioner's Requests for Admissions; and
- ii) That there are genuine disputes of material fact existing in this case.

ARGUMENT

As basis for the Registrant's first contention above, the Registrant provides that its Responses to Petitioner's Requests for Admissions should not be deemed admitted because the mandatory discovery conference was not held in this matter. Despite the foregoing, on or about January 27, 2015 Registrant's former counsel, the late Jerry Romanoff, Registrant's President: David McCutcheon and Petitioner's undersigned counsel timely held the mandatory Discovery Conference in this matter. As such, the Discovery Conference in the instant case was timely and properly conducted prior to the Board's original deadline to hold the discovery conference on or about February 13, 2015 (as provided in the Board's original Trial Order entered in this case on or about December 5, 2014). Based on the foregoing the Registrant's contention that its Responses to Petitioner's Requests for Admissions should not be deemed admitted because no discovery conference was held in the instant case is unfounded, without merit and should be given no consideration.

Furthermore, it should be noted that Petitioner's Requests for Admissions along with Petitioner's Requests for Interrogatories and Petitioner's Requests for Production of Documents were properly served upon Registrant's former counsel of record on July 6, 2015, (which is the same date discovery opened in this case per the Board's Order entered on or about June 5, 2015) via U.S. Mail with a courtesy copy via electronic mail (*See* Petitioner's Motion for Summary Judgment, Exhibits A and B). It should also be noted that at the time Petitioner's Requests for Admissions were served to Registrant's former counsel

prior to the close of the discovery period in this case on January 2, 2016 as provided in the Board's Order entered on June 5, 2015 in the instant case.

Turning to Registrant's second argument above, it is respectfully submitted that Petitioner's claim that there are no genuine issues of material fact in this case is *indeed* in fact based on the evidence in this case in consideration of Registrant's Responses to Petitioner's Requests for Admissions, or lack thereof.

In sum, there is no argument that Registrant has not provided timely answers to the Petitioner's requests for admissions and has not requested withdrawal or amendment of the admissions. Moreover, Fed. R. Civ. P. 36(a) provides that a matter is admitted unless a response is timely served or "the [Board] on motion permits withdrawal or amendment of the admission". Furthermore in *American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 117, 19 USPQ2d 1142, 1144 (5th Cir. 1991), it was established that the Board may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend. Based on the foregoing it is respectfully submitted that Petitioner's requested admissions should be deemed to be admitted by Registrant since Registrant neither responded to Petitioner's requested admissions nor objected thereto within thirty (30) days after the date of service of Petitioner's Requests for Admissions. See FRCP 36(a) and TBMP § 411.01.

CONCLUSION

WHEREFORE for the premises considered, Registrant by way of its Opposition to Petitioner's Motion for Summary Judgment has not sufficiently met the burden of showing that genuine issues of material fact exist that can contradict Petitioner's claims of priority and likelihood of confusion based on the admissible evidence in the case to date and/or that Registrant's Responses to Petitioner's Requests for Admissions should not be deemed admitted. As such, Petitioner respectfully requests that Petitioner's Motion for Summary Judgment be granted and this matter be dismissed with prejudice.

DATED this 11th day of January, 2016.

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